

SECTION III—REMARKS

This Amendment is submitted in response to the Office Action mailed June 9, 2003. No claims are amended herein, and claims 1, 3-5, 7, 8, 19 and 21-26 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the following remarks.

Double Patenting Rejection

The Examiner provisionally rejected claims 1, 3-5, 7, 8, 19 and 21-26 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 19-26 of co-pending U.S. patent application serial no. 09/895,426. According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other.

Applicant respectfully traverses the Examiner's rejections on two grounds. First, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application. 35 U.S.C. § 121; MPEP § 804(II). The present application is a divisional of the co-pending parent application cited by the Examiner, and was filed in response to a restriction in the parent application. A double patenting rejection is therefore inappropriate in the present application. Second, in the co-pending parent application claims 10-18 were elected in response to the restriction requirement, and claims 1-9 and 19-26 were canceled, since these claims are being prosecuted in the present application. Claims 1-9 and 19-26 therefore are no longer pending in the parent application, so there are no conflicting claims and a double patenting rejection is inappropriate. For both these reasons, Applicant respectfully requests withdrawal of the provisional double patenting rejection.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 19, and 21-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,704,650 to Laurash et al ("Laurash"), U.S. Patent No. 6,536,660 to Blankenship et al ("Blankenship") and one or both of U.S. Patent Nos. 5,783,810 and 5,793,030 to Kelly, Jr. (collectively "Kelly"). The Examiner did not specify to which of the Kelly references he was referring. One Kelly reference is a divisional

of the other and therefore has an identical specification, so for the argument below both references will collectively be referred to as “Kelly.”

The Examiner alleges that Laurash discloses first and second labels with a printed identifier, but concedes that it does not disclose a component container, an identifier that identifies a component inside the component container, or an identifier electronically stored in the component and read therefrom for printing labels. Similarly, the Examiner alleges that Kelly discloses a component container having components and a device inside the component container, wherein a label is removably affixed to the component container and has an identifier (*i.e.*, a bar code) that identifies the component inside the container, but the Examiner concedes that Kelly also does not disclose an identifier electronically stored in the component and read therefrom for printing the labels. Finally, the Examiner alleges that Blankenship discloses an identifier that can be electronically stored on a component (in this case a wire), read and placed as a bar code on an adhesive label, wherein the adhesive label is placed on any desirable surface, such as a reel or barrel for holding wire. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laurash and Kelly to include an identifier electronically stored and encoded on a label as taught by Blankenship for the purpose of providing the end user with tracking information pertaining to the component.

Applicant respectfully traverses the Examiner’s rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 1 recites, among other things, an article of manufacture comprising a component container and “first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels.” Laurash, Kelly and Blankenship do not, alone or in combination, disclose, teach or suggest all the claimed limitations. As discussed above, the Examiner concedes that Laurash and Kelly do not disclose an identifier electronically stored in the component and read therefrom for printing on labels. Contrary to the Examiner’s assertion,

Blankenship also does not disclose such a limitation. Blankenship discloses that information regarding a welding wire can be stored in the welding wire itself. The same information stored in the wire can also be encoded in a bar code and printed on a label. In Blankenship, however, the information is collected during manufacturing and stored on the wire, encoded in a label, or both (col. 3, lines 3-32). The wire, however, is never the source of the information for the bar code: once stored on the wire, the information is never read from the wire for use in the encoding or printing of a label. Laurash, Kelly and Blankenship therefore cannot disclose, teach or suggest, alone or in combination, an article of manufacturing including “first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels.” Applicant submits that claim 1 is therefore in condition for allowance and respectfully requests withdrawal of the rejection.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant therefore respectfully submits that claims 3-5, 7 and 8 are allowable by virtue of their dependence on allowable claim 1 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and “first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component and read therefrom for printing on the identification labels.” As discussed above in connection with claim 1, Laurash, Blankenship and Kelly do not disclose, teach or suggest an article of manufacture having the recited combination of features. Applicant submits that these references cannot render the claimed invention obvious, and therefore respectfully requests withdrawal of the rejection.

Regarding claims 20-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d

1071 (Fed. Cir. 1988). As discussed above, claims 19 is in condition for allowance. Applicant therefore respectfully submits that claims 20-26 are allowable by virtue of their dependence on allowable claim 19 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, independent claims 1 and 19 are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 8-13-03



Todd M. Becker
Attorney for Applicant(s)
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606
Enclosures: Postcard